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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,946	02/25/2004	Robert Gerald Taylor	030312TAYLOR	3785

7590 09/27/2005

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EXAMINER

MENDIRATTA, VISHU K

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/786,946	Applicant(s) TAYLOR, ROBERT GERALD	
	Examiner Vishu K. Mendiratta	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-13 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) 7-13 and 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>24/04</u> | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Newly submitted claims 7-13,15-17 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Article of manufacture as a kit supply and Method of playing a board game.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 7-13,15-17 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Specification

2. The disclosure is objected to because of the following informalities: The drawing Fig.1A is not true to the specification as understood from page 9 (from clean copy of specification). It is unclear how “number of spaces (e g. 12 in line seven) is ***inversely*** proportional to the probability of rolling a combination (e g. 6 which is the probability of rolling a seven). As understood from the applicant’s invention the number of spaces in a track increases as the probability of the roll combinations increases that is ***direct*** proportion.

Direct proportion

If A and B are in direct proportion, then as one grows bigger the other also grows bigger by the same proportion (or ratio). For example, if B doubles then A doubles. This can be written as $A \propto B$ or $A = kB$ (where k is a constant multiplier).

the multiplier rule – if A is multiplied by a value then B must be multiplied by the same value.

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Inverse proportion

If A is inversely proportional to B , then as B gets bigger A gets smaller by the same factor. For example, if B is increased by a factor of 2 (B doubles) then A decreases by a factor of 2 (A is halved). This can be written as:

$$A \propto 1/B \text{ or } A = k/B$$

Appropriate correction is required.

3. Claims 3-6 objected to because of the following informalities:

Claims 3-6 are not true to examiner's understanding of the "inverse proportional rule".

Inverse proportion

If A is inversely proportional to B , then as B gets bigger A gets smaller by the same factor. For example, if B is increased by a factor of 2 (B doubles) then A decreases by a factor of 2 (A is halved). This can be written as:

$$A \propto 1/B \text{ or } A = k/B$$

Appropriate correction is required.

4. The amendment filed (drawings and claims dated 7/12/05, specification dated 5/31/05) is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicant has added new matter in terms of number of spaces in lanes. Applicant has also added new matter in terms of number of spaces in drawing.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

5. Claims 3,4 rejected under 35 U.S.C. 102(b) as being anticipated by Welsh (4729568).

Claim 3: Welsh teaches a game board with two dice (22), playing pieces (26), each race track having a start (18) and finish (2F-12F) positions, tracks having 2-12 playing positions (16) that are directly proportional to the probability of roll combinations.

Applicant may note that as explained above in the above paragraphs it appears that the applicant means “when probability grows so does number of spaces in a lane”.

Claim 4: Welsh teaches cards (Fig.3), tokens (28), colored indicators and receptacle (Fig.6).

Claim Rejections - 35 USC § 103

6. Claims 5-6 rejected under 35 U.S.C. 103(a) as being unpatentable over Welsh. Welsh teaches all limitations except that it does not teach playing pieces being miniatures cars of model scales.

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Examiner takes the position that whereas some players like horse racing game, others like car racing as a matter of interest. In order to attract potential players, it would have been obvious to aesthetically modify Welsh game pieces to miniature cars of model proportions. One of ordinary skill in art at the time the invention was made would have suggested modifying Welsh game pieces to miniature cars.

Response to Arguments

7. Applicant's arguments with respect to claims 3-6 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

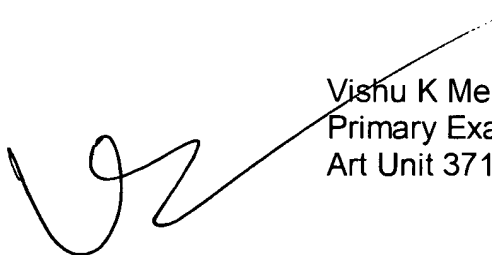
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishu K. Mendiratta whose telephone number is (571) 272-4426. The examiner can normally be reached on Mon-Fri 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (571) 272-4415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Vishu K Mendiratta
Primary Examiner
Art Unit 3711

VKM
September 21, 2005